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Paper No. 13

In re Application of
Bruce L Hawkins
Application No. 09/871,271
Filed: May 31, 2001
Attorney Docket No. 08002.00011

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: DECISION ON PETITION
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This is a decision on the petition filed on April 6, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office action dated June 5, 2002. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is denied.

Petitioner alleges that a reply to the Office letter in question was filed on September 12, 2002, but that the "original invitation to pay for a one month extension" was mailed from the Office on December 17, 2002, nearly twelve weeks after the Office letter in question was received by counsel's offices, and that counsel's offices were closed from December 15, 2002 until January 2, 2003. Petitioner further alleges that had the "invitation" to pay for a one-month extension been timely received, petitioner would have responded to it. Petitioner notes that the one-month extension fee was paid on January 3, 2003, and that petitioner had done all that could be done to maintain the application in pending status.

35 USC § 133 reads as follows:

Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.136 reads, in pertinent part, as follows:

1.136 Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or
- (v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and § 1.645 for extensions of time in interference proceedings.

In MPEP § 710.02(b), it is stated that the time for filing a reply to any Office action on the merits is to be set at three months from the date of mailing the Office action.

MPEP § 711.03(c) reads, in pertinent part:

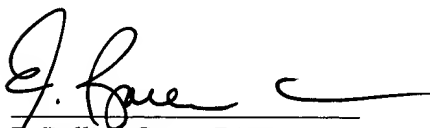
Evidence of nonreceipt of an Office communication or action (e.g. Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. (Citations omitted.)

The record shows that an Office action setting a three month shortened statutory period was mailed to the correspondence address of record on June 5, 2002. Therefore, a reply to this Office letter was due on or before September 5, 2002, a Thursday and a regular business day within the District of Columbia (see 37 CFR 1.5). This Office letter was clearly received at the correspondence address of record because the record shows that on September 12, 2002, a response thereto was filed by petitioner. The response has affixed thereto a 37 CFR 1.8(a) certificate of mailing, and the certificate is dated September 6, 2002. The response was, therefore, not timely filed. Under 35 USC § 133 and 37 CFR 1.136(a), petitioner was required to obtain an appropriate extension of time in order to render the otherwise untimely filing timely. Petitioner did not obtain the necessary extension of time. As indicated in MPEP § 711.03(c), the failure to receive (timely or otherwise) an Office communication other than that action to which reply was required to avoid abandonment (in this case a letter informing petitioner that the reply filed on September 12, 2002 was late and that an extension of time would be required) does not operate to avoid abandonment by operation of 35 USC § 133 or warrant withdrawal of the holding of abandonment. The fact that petitioner was not appraised of the necessity of obtaining an extension of time until after the maximum statutory period of six months permitted by 35 USC § 133 had expired does not operate to avoid the abandonment or to warrant withdrawal of the proper holding that the application in fact stands abandoned.

For the foregoing reasons, none of the allegations contained in the petition are persuasive that the holding of abandonment was improper. Therefore, there is no basis upon which to withdraw the holding of abandonment. While petitioner is entitled to request reconsideration of this decision, without fee, provided that the request is timely filed in accordance with 37 CFR 1.181(f), it would appear that petitioner's remedy is to proceed pursuant to 37 CFR 1.137.

The application is being returned to storage as an abandoned file.

PETITION DENIED.


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